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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/776,255	02/02/2001	Robert W. Anthony	0550862-0013	9733
7590	09/15/2005		EXAMINER	
Orchid Systems, Inc. 103 Old Colony Road Wellesley, MA 02181			MEINECKE DIAZ, SUSANNA M	
			ART UNIT	PAPER NUMBER
			3623	

DATE MAILED: 09/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/776,255	ANTHONY, ROBERT W.
	Examiner	Art Unit
	Susanna M. Diaz	3623

-- The MAILING DATE of this communication app ars on the cover sheet with the correspond nc address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 31 March 2005.

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-3 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-3 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 02 February 2001 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1/25/02

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

1. This non-final Office action is responsive to Applicant's response to the Requirement for Information under 37 C.F.R. 1.105 filed March 31, 2005. Claims 1-3 are pending.

### ***Oath/Declaration***

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not identify the city and either state or foreign country of residence of each inventor. The residence information may be provided on either on an application data sheet or supplemental oath or declaration.

### ***Specification***

#### ***Content of Specification***

- (a) Title of the Invention: See 37 CFR 1.72(a) and MPEP § 606. The title of the invention should be placed at the top of the first page of the specification unless the title is provided in an application data sheet. The title of the invention should be brief but technically accurate and descriptive, preferably from two to seven words may not contain more than 500 characters.
- (b) Cross-References to Related Applications: See 37 CFR 1.78 and MPEP § 201.11.
- (c) Statement Regarding Federally Sponsored Research and Development: See MPEP § 310.
- (d) The Names Of The Parties To A Joint Research Agreement: See 37 CFR 1.71(g).

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(e) Incorporation-By-Reference Of Material Submitted On a Compact Disc: The specification is required to include an incorporation-by-reference of electronic documents that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application. See 37 CFR 1.52(e) and MPEP § 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text were permitted as electronic documents on compact discs beginning on September 8, 2000.

Or alternatively, Reference to a "Microfiche Appendix": See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.

(f) Background of the Invention: See MPEP § 608.01(c). The specification should set forth the Background of the Invention in two parts:

- (1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions of the subject matter of the claimed invention. This item may also be titled "Technical Field."
- (2) Description of the Related Art including information disclosed under 37 CFR 1.97 and 37 CFR 1.98: A description of the related art known to the applicant and including, if applicable, references to specific related art and problems involved in the prior art which are solved by the applicant's invention. This item may also be titled "Background Art."

(g) Brief Summary of the Invention: See MPEP § 608.01(d). A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.

(h) Brief Description of the Several Views of the Drawing(s): See MPEP § 608.01(f). A reference to and brief description of the drawing(s) as set forth in 37 CFR 1.74.

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- (i) Detailed Description of the Invention: See MPEP § 608.01(g). A description of the preferred embodiment(s) of the invention as required in 37 CFR 1.71. The description should be as short and specific as is necessary to describe the invention adequately and accurately. Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention described and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, the specification should refer to another patent or readily available publication which adequately describes the subject matter.
- (j) Claim or Claims: See 37 CFR 1.75 and MPEP § 608.01(m). The claim or claims must commence on separate sheet or electronic page (37 CFR 1.52(b)(3)). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There may be plural indentations to further segregate subcombinations or related steps. See 37 CFR 1.75 and MPEP § 608.01(i)-(p).
- (k) Abstract of the Disclosure: See MPEP § 608.01(f). A brief narrative of the disclosure as a whole in a single paragraph of 150 words or less commencing on a separate sheet following the claims. In an international application which has entered the national stage (37 CFR 1.491(b)), the applicant need not submit an abstract commencing on a separate sheet if an abstract was published with the international application under PCT Article 21. The abstract that appears on the cover page of the pamphlet published by the International Bureau (IB) of the World Intellectual Property Organization (WIPO) is the abstract that will be used by the USPTO. See MPEP § 1893.03(e).
- (l) Sequence Listing: See 37 CFR 1.821-1.825 and MPEP §§ 2421-2431. The requirement for a sequence listing applies to all sequences disclosed in a given application, whether the sequences are claimed or not. See MPEP § 2421.02.

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology

often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

4. The abstract of the disclosure is objected to because it is too long. Correction is required. See MPEP § 608.01(b).

5. The disclosure is objected to because of the following informalities:

The appendix is improper since only computer program listings up to 10 pages long are allowed in the appendix.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-3 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1-3 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

As per claim 1, it is not understood which steps would be performed by which mode of communication (i.e., phone, fax machine, or remote qualifier computer). What is the intended scope of involvement of each mode of communication with the performance of the respective steps? It seems that a human would actually carry out the analysis associated with the steps in question, especially the steps of determining, conducting, inquiring, rejecting, and estimating, while the modes of communication would merely transmit data back and forth between the remote qualifier site and prospect site (as per the claim language as well as Applicant's disclosure). The recited steps are subjectively performed by a human. Applicant's specification does not disclose any quantifiable or otherwise repeatable means or methodology for producing consistent results for the steps of determining, conducting, inquiring, rejecting, and estimating. For example, the steps of determining if the prospect remains qualified after every respectively intervening step is carried out by a human. The metes and bounds of this repeated determination are unclear because the results of the determination steps are based on the complete subjectivity of a human user. The specification does not provide adequate written disclosure to enable an artisan of ordinary skill in the art to make and/or use the invention as intended by the Applicant since the invention could be

utilized differently by each human user in light of differences in subjectivity among humans.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-2 are directed toward a system; however, the system comprises various sites. A site is merely a location, which does not expressly impart any structure. Even though the remote qualifier site "includes" a phone, fax machine, remote qualifier computer, a qualifier database, an e-mail client, a modem, and a Web browser, the remote qualifier site does not comprise these elements. In other words, these elements are just situated within the remote qualifier site and are not clearly integrated as a conglomerated system. Similarly, even though the prospect site is described as "having" a prospect phone, a prospect fax, a host computer, a data storage device, host applications, a prospect e-mail client, a modem, and a prospect Web browser, the prospect site does not comprise these elements. In other words, these elements are just situated within the prospect site and are not clearly integrated as a conglomerated system.

Claim 1 recites "wherein a remote qualifier *may* remotely qualify a prospect's data stream transformation project proposal using the phone, fax machine and remote

qualifier computer to communicate with the prospect site to execute the steps of..." (lines 13-15). Use of the word "may" implies that the recited steps (line 17 of the first page of claim 1 to the end of the claim) are optional, thereby rendering the scope of claims 1 and 2 indefinite. Furthermore, it is not understood which steps would be performed by which mode of communication (i.e., phone, fax machine, or remote qualifier computer). What is the intended scope of involvement of each mode of communication with the performance of the respective steps? It seems that a human would actually carry out the analysis associated with the steps in question, especially the steps of determining, conducting, inquiring, rejecting, and estimating, while the modes of communication would merely transmit data back and forth between the remote qualifier site and prospect site (as per the claim language as well as Applicant's disclosure). For example, the steps of determining if the prospect remains qualified after every respectively intervening step is carried out by a human. The metes and bounds of this repeated determination are unclear because the results of the determination steps are based on the complete subjectivity of a human user, further rendering the claims vague and indefinite. Similar limitations are recited in claim 3; therefore, the same rejections apply.

Appropriate correction is required.

***Claim Rejections - 35 USC § 101***

10. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

11. Claims 1-3 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the “progress of science and the useful arts” (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. Mere intended or nominal use of a component, albeit within the technological arts, does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process.

While claims 1-3 produce what is likely a useful result, due to the inability of an artisan skilled in the art to reproduce the results consistently due to the subjective nature of the recited steps (as discussed in the rejections under 35 U.S.C. § 112, 1<sup>st</sup> and 2<sup>nd</sup> paragraphs above), the concreteness and tangibility of claims 1-3 are placed into doubt. Furthermore, claims 1-2 merely recite a nominal use of technology since technology is only used to transmit data back and forth between the remote qualifier site and prospect site. Technology does not have a substantial effect on the practice of the

claimed invention. Additionally, claim 3 fails to recite any technology. Therefore, claims 1-3 are deemed to be non-statutory for failure to produce a concrete and tangible result as well as for failure to sufficiently incorporate the technological arts.

Appropriate correction is required.

*In light of the numerous rejections under 35 U.S.C. § 101 and 112, 1<sup>st</sup> and 2<sup>nd</sup> paragraphs, presented above, the following art rejection reflects Examiner's best understanding of the claimed invention.*

#### ***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted prior art (as discussed in Applicant's response to the Requirement for Information under 37 C.F.R. § 1.105 filed March 31, 2005).

In the Requirement for Information under 37 C.F.R. § 1.105 (mailed February 14, 2005), the Examiner requested not only a discussion of the prior art, but also an explanation of how the claimed invention compares to the prior art. In Applicant's admitted prior art (as discussed in Applicant's response to the Requirement for Information under 37 C.F.R. § 1.105 filed March 31, 2005), Applicant states, "A key

improvement in the patent application is starting with a remote communications connection in order to develop the design phases and perform the qualifications before expending Vendor technical resources onsite. At the same time, this means that details are captured in digital format whereas past projects were often designed from screen prints..." (Page 2 of Applicant's response filed March 31, 2005) Applicant also admits, "Rather than the Vendor salesperson going onsite and writing notes, the invention connects the Vendor technicians to the Prospect's existing application to exercise the application directly, copying any desired detail in digital format." (Page 3 of Applicant's response filed March 31, 2005) Applicant's admissions imply that the underlying methodology for qualifying a prospect's data stream transformation project proposal is prior art; Applicant's asserted novelty is the interface that allows for real-time communications between a remote qualifier site and a prospect site in order to make fairly immediate qualification decisions at various steps in the overall qualification process.

However, Official Notice is taken that it is old and well-known in the art of prospect qualification to perform a qualification methodology remotely through use of a phone, fax machine, computers, Web browsers, data storage devices, modems, or a combination thereof. For example, Internet communications among various enterprises typically involve computers, Web browsers, data storage devices, and modems. Use of the phone, fax machine, computer, and Internet communications system facilitate quick and relatively inexpensive communications among globally located entities. Therefore, the Examiner submits that it would have been obvious to one of ordinary skill in the art

at the time of Applicant's invention to implement the underlying methodology for qualifying a prospect's data stream transformation project proposal (admitted by Applicant as prior art) through use of a phone, fax machine, computers, Web browsers, data storage devices, modems, or a combination thereof in order to facilitate quick and relatively inexpensive communications among globally located entities, thereby providing qualifiers with a larger source of potential prospects and vice-versa.

Furthermore, Official Notice is taken that it is old and well-known in the art of prospect qualification to establish multiple qualification stages to filter out prospects at each progressive stage. For example, candidates for a job or proposal for a project may be filtered out in a first stage based on whether or not they meet basic skill or cost requirements. A second stage could further filter out candidates based on results of an interview or proposal presentation. A final, and more rigorous, evaluation could be applied in the last stage to make a final qualification decision. Performing various steps of filtering to identify qualified prospects typically lowers the cost of qualifying prospects since the more rigorous, and often more costly, qualification tests are reserved for only a few select prospects. Applicant's admitted prior art places the claimed invention in the same field of endeavor (i.e., qualifying prospects); therefore, the Examiner submits that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to establish multiple qualification stages to filter out prospects at each progressive stage (as represented by the various repeated steps of "determining if the prospect remains qualified after the previous step" recited in claims 1-3) in order to identify qualified prospects at a lower cost of qualifying prospects since the more

rigorous, and often more costly, qualification tests are reserved for only a few select prospects.

### ***Conclusion***

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (571) 272-6733. The examiner can normally be reached on Monday-Friday, 10 am - 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Susanna Diaz*  
Susanna M. Diaz  
Primary Examiner  
Art Unit 3623

September 11, 2005